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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/627,522	07/28/00	TAYLOR M	510553.90940

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
1745	11

DATE MAILED: 10/19/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/627,522	Taylor et al.
Examiner	**Art Unit**
Tracy Dove	1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *30 Jul 2001*.

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *30-71* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *30-71* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other:

DETAILED ACTION

This Office Action is in response to the communication filed on 7/30/01. Applicant's arguments have been considered, but are not persuasive. Claims 30-71 are rejected in view of the prior art of record. This Action is made **FINAL**, as necessitated by amendment.

Information Disclosure Statement

The information disclosure statement filed 7/30/01 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of the Declaration of M. Eric Taylor dated 4/6/00 was not found.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 30-71 are rejected under the judicially created doctrine of double patenting over claims 1-33 of U. S. Patent No. 6,117,594 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: both the instant application and the patent are directed toward a grid for a lead acid battery having a lead based alloy of lead, tin, calcium and silver. The only difference between the claims of the instant invention and the claims of the patent is in the range of silver contained in the lead based alloy. The silver range of greater than 0 to about 0.02% (instant invention) was narrowed during the prosecution of the patent to a silver range of greater than 0 to about 0.015%.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Applicant is advised that should claim 62 be found allowable, claim 67 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing,

despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 70 and 71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 states "The plate of Claim 58 further comprising a container for an automotive battery". However, the plate does not comprise the container.

Claim 71 recites the limitation "The plate of Claim 30". The claim should recite "The lead-acid cell of Claim 30".

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 30-38, 40-52, 54-56, 63 and 71 are rejected under 35 U.S.C. 102(e) as being anticipated by and alternatively under 35 U.S.C. 103(a) as being unpatentable over Rao et al. 5,874,186.

See Office Action of 2/27/01 for the reasons for rejection.

Claims 39, 53, 57-62 and 64-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rao US 5,874,186.

See Office Action of 2/27/01 for the reasons for rejection.

Response to Arguments

Applicant's arguments filed 7/30/01 have been fully considered but they are not persuasive.

Double Patenting

The double patenting rejection will be held in abeyance and will be addressed by Applicant if allowable subject matter is indicated by the Examiner.

35 U.S.C. 102(e)/103(a) Rejection

Applicant argues the subject matter of independent claims 30 and 44 is not identically disclosed or described in Rao. Specifically argued, Rao does not teach a lead alloy having a silver content in the range of greater than 0 to about 0.02%.

Examiner disagrees, Rao teaches a lead alloy having a silver content in the range of 0.018 to 0.030%. Alternatively, Rao teaches a lead alloy having a silver content in the range of 0.017 to 0.030%. The silver range disclosed by Rao overlaps with the claimed range of silver (claims 30 and 44). Thus, the claims are anticipated.

Applicant argues the subject matter recited in the instant claims must be disclosed in the Rao patent with "sufficient specificity to constitute an anticipation under the statute". Applicant refers to specific examples in Rao which teach a silver content *outside the range of silver claimed in the Rao patent*. The examples are used to distinguish between the different casting methods for the lead alloy grids, not the silver content of the lead alloys. Furthermore, Rao is not limited to the examples. Rao teaches inclusion of silver in the range of about 0.018% to about 0.030% and tin in the range of from about 0.6 or 0.65% to 1.25% provides high temperature corrosion resistance while minimizing creep-induced deformation. The combination of the silver and tin ranges should be coordinated to reduce the susceptibility of the directly cast strip to *hot-*

cracks and hot-tear type defects. Unduly high tin and silver levels may cause brittleness in the cast strip. See col. 16, lines 28-37.

Applicant argues no proper modification of the alloy composition of Rao would result in the "grid supporting structure" recited in Claims 30 and 44. However, the skilled artisan would have known that "about 0.018%" renders the claimed silver range of "about 0.005 to about 0.017%" obvious. The instant claims and the Rao patent use language such as "about"when describing and claiming the ranges of calcium, tin and silver in the lead based alloy. Language such as "about" is interpreted broadly when applying prior art.

35 U.S.C. 103(a)

Applicant does not specifically address the obvious rejection of claims 39 and 53.

Regarding the argument concerning unexpected results, a copy of the declaration of M. Eric Taylor dated 4/6/00 was not found. Applicant refers to an affidavit or declaration filed in the parent application. Affidavits or declarations, such as those under 37 CFR 1.131 and 37 CFR 1.132, filed during prosecution of the parent application do not automatically become a part of this application. Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make the remarks of record in the later application and include a copy of the original affidavit or declaration filed in the parent application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Dove whose telephone number is (703) 308-8821. The Examiner may normally be reached *Monday-Thursday from 8:00 AM - 6:30 PM.* My supervisor is Gabrielle Brouillette, who can be reached at (703) 308-0756. The Art Unit receptionist can be reached at (703) 308-0661 and the official fax number is (703) 305-3599.

October 18, 2001

CAROL CHANEY
PRIMARY EXAMINER